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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,330	12/20/2001	Isabelle Rollat	05725.0922-00	5705

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/023,330	Applicant(s) ROLLAT ET AL.	
	Examiner Lauren Q Wells	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 167-169, 171, 172, 174, 175, 177, 178, 180-182 and 185-308 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 167-169, 171, 172, 174, 175, 177, 178, 180-182 and 185-308 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 167-169, 171-172, 174-175, 177-178, 180-182, 185-308 are pending.

The Terminal Disclaimer filed 3/10/04, is sufficient to overcome the obviousness-type double patenting rejection over co-pending Application No. 09/627,055.

102 Rejection Maintained

The rejection of claims 167-169, 171-172, 174-175, 177-178, 180-182, 185-303 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 12-14, 16-23, 28-41, 44-46, 48-55, 60-70 and 72 of copending Application No. 10/022,253 is MAINTAINED for the reasons set forth in the Office Action mailed 9/10/03, and those found below.

Applicant argues, "The claims of copending Application No. 10/022,253 are directed to non-rinse compositions, whereas the claims of the present application are directed to shampoos and conditioners, i.e., rinse compositions. These are express structural limitation on the respective claims". This argument is not persuasive. First, it is respectfully pointed out that recitations "shampoo", "conditioner", "non-rinse composition", have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

It is further respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, there are no structural differences between the two compositions.

Applicant is merely arguing the differences in their methods of use.

103 Rejection Maintained

The rejection of claims 167-169, 180-182, 185-208, 284-307 under 35 U.S.C. 103(a) as being unpatentable over Yang et al. (6,013,722) is MAINTAINED for the reasons set forth in the Office Action mailed 9/10/03, and those found below.

The rejection of claims 167-169, 171-172, 174-175, 177-178, 180-182, 185-308 under 35 U.S.C. 103(a) as being unpatentable over Engel et al. (2002/0058754) in view of Yang et al. (6,013,722) is MAINTAINED for the reasons set forth in the Office Action mailed 9/10/03, and those found below.

Applicant argues, "Yang et al. fails to teach or suggest a 'hair styling' composition. . . The invention is restricted to those [compositions] that as [hair styling compositions] as defined in the specification, which is not true with respect to [compositions] constructed with the limitation of [the recited polymer and surfactant] only. . . The phrase, a reshaphable hair styling composition, is a limitation that is 'necessary to give life, meaning, and vitality' to Applicants' claims". This argument is not persuasive. For reasons of record the intended use and preamble of the instant claims are not afforded patentable weight. A composition is a composition regardless of its use. Furthermore, there is nothing in Yang et al. or Engel et al. that is toxic, rendering the

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compositions unsuitable for cosmetic use. It is further pointed out that pressure sensitive adhesive polymers are well known in the art for use as hair fixatives. The Examiner respectfully points out that if Applicant thinks the use of his invention is novel, then Applicant should claim a method and not a composition. The Examiner disagrees that the instant preamble gives life, meaning, and vitality to the instant claims.

Applicant argues, “Yang et al. fails to teach or suggest ‘at least one surfactant’. . . Yang et al. only teaches the use of surfactants in the emulsion polymerization process from which the (meth)acrylic polymer is a product”. This argument is not persuasive. As pointed out in the previous Office Action, see page 4, last paragraph, Yang et al. teach surfactants as additional ingredients. It is respectfully pointed out that a reference is not limited to its exemplifications or preferred embodiments, but is relied upon as a whole for what it teaches one of ordinary skill in the art.

Applicant argues, “Yang et al. fails to teach or suggest the combination of N-butyl acrylate, 2-hydroxyethyl (meth)acrylate, and 2-ethyl hexyl acrylate monomers”. This argument is not persuasive. The Examiner is not clear why Applicant makes this argument. Yang et al. specifically teaches the copolymer comprising n-butyl acrylate, 2-hydroxyethyl (meth)acrylate, wherein 2-ethyl hexyl acrylate is specifically taught as an optional co-polymerizable monomer in the copolymer.

Applicant argues, “Nothing in Yang et al. suggests that it’s ranges can be modified from those disclosed. Further nothing in Yang et al. associates modifying these weight percentages, such as of n-butyl acrylate, with any particular property”. This argument is not persuasive. First, it is pointed out that the only percent weight not taught by Yang et al. is the 30-40% n-butyl

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acrylate in claims 180 and 181. Second, as pointed out in the previous Office Action, modifying percent weights is within the skill of the artisan. Third, it is within the skill of the artisan to modify the amounts of different monomers in a polymer that is an adhesive because of the expectation of increasing or decreasing the amount of adhesion.

Applicant argues, “Yang et al. fails to teach or suggest a ‘reshapable effect’ . . . the Examiner has asserted that ‘reshapable effect’ is merely a use that can be ignored”. This argument is not persuasive. First, it is respectfully pointed out that Applicant has mischaracterized the Examiner’s statement in the previous Office Action. The previous Office Action clearly states that a “reshapable effect” is an intended use that is not given patentable weight, as it does not result in a structural difference between the claimed invention and the prior art. For reasons of record, this intended use is not afforded patentable weight.

Applicant argues, “the Examiner has not established that the pressure sensitive adhesives of Yang et al. are identical to Applicants’ compositions”. This argument is not persuasive. First, it is respectfully pointed out that the instant rejection is 103-obviousness rejection and not a 102-anticipation rejection. For reasons of record, the teachings of Yang et al. render the instant composition obvious. Furthermore, while Yang et al. does not exemplify the instant composition, the teachings of Yang et al. teach the instant composition.

Applicant argues, “there can be no basis in fact to say that the Yang et al.’s disclosure of a product family or method of manufacture is also a disclosure of a composition with a reshapable effect”. This argument is not persuasive. Yang et al. teach the composition comprising the polymer of the instant claims. Since a compound and its properties are

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inseparable and Yang et al. teach the same polymer composition, the composition of Yang et al. has the same properties.

Applicant argues, “it is only a mere possibility that one of ordinary skill in the art looking at Yang et al. would select at least one (meth)acrylic polymer, as claimed, and then attempt to use it in a manner such that a composition is formed that provides a reshapable effect, as required by all pending claims”. This argument is not persuasive. Applicant is arguing the intended use of the instant composition, i.e. “use it in a manner. . .”. The instant claims are product claims and NOT method of use claims.

Applicant argues, “There is no motivation in Yang et al. or the prior art to duplicate the claims’ selection of monomers” and that “the Examiner is improperly picking, choosing, and combining various disclosures within Yang et al.”. This argument is not persuasive. Yang et al. specifically teach a copolymer comprising n-butyl acrylate, 2-hydroxyethyl (meth)acrylate, and a copolymerizable monomer, wherein 2-ethyl hexyl acrylate is specifically taught as a copolymerizable monomer. This is not “improper picking, choosing, and combining”, but is relying on the teachings of the reference.

Applicant argues, “Both references fail to teach or suggest a ‘hair styling’ composition”. This argument is not persuasive. It is respectfully pointed out that the recitation ‘a hair styling composition’ has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or

structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant argues, “Both references fail to teach or suggest ‘at least one conditioner’”. This argument is not persuasive. As pointed out in the instant rejection, Engel et al. specifically teach moisturizers, wherein moisturizers are conditioners.

Applicant argues, “Both references fail to teach or suggest the combination of N-butyl acrylate, 2-hydroxy ethyl (meth)acrylate, and 2-ethyl hexyl acrylate monomers”. This argument is not persuasive. See above, where this argument was addressed.

Applicant argues, “Both references fail to teach or suggest a ‘resphapable effect’”. This argument is not persuasive. See above, where this argument was addressed.

Applicant argues, “There is no motivation in the references to duplicate the claims’ selection of monomers”. This argument is not persuasive. See above, where this argument was addressed.

Applicant argues, “There is no motivation to use Yang et al.’s polymers in Engel et al.’s skin compositions”. This argument is not persuasive. Engel et al. teach the monomers of the instant claims and Yang et al. Engel et al. teach their polymers as adhesives. For reasons of record, one of skill would be motivated to look to Yang et al. for the specific construction of the monomers in a polymer for the purpose of providing an adhesive polymer.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

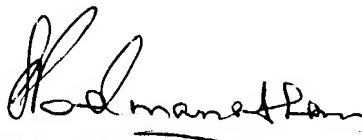
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw


SREENI PADMANABHAN
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